



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Mo

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/315,796 05/20/99 DAVIS

B WILL-2501

EXAMINER

MM91/0417

ROBERT HARDY FALK
FALK & FISH LLP
P. O. box 794948
DALLAS TX 75397

FUNK, S

ART UNIT

PAPER NUMBER

2854

48

DATE MAILED:

04/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

09315796-052099

Office Action Summary

Application No.
09/315,796

Applicant
Davis et al.

Examiner
Stephen R. Funk

Art Unit
2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-151 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 12-14, and 39-41 is/are allowed.
- 6) ☒ Claim(s) 6-11, 15-38, and 42-151 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

SUPPLEMENTAL OFFICE ACTION

The previous office action has been replaced with the following action resetting the time period for 3 months. It has been pointed out that MPEP 1442.01 states that a 1 month time period will be set for reissue applications which are being examined after litigation has been stayed, dismissed, etc. *to allow for consideration by the Office*. Since the litigation was not specifically dismissed so as to allow consideration by the Office, the time period has been set for 3 months from the mail date of this Office Action. Note also MPEP 710.06.

650250-965750
The amendments to the specification filed on July 7, 2000 have been entered to the original specification with the exception of the paragraph in column 4 lines 46 - 51. Applicant should resubmit the entire paragraph in column 4 lines 46 - 51 with deleted language bracketed and added language underlined. (Applicant's amendment to column 4 lines 46 - 51 has not been entered as the proposed paragraph unofficially omits the word "An", which existed in the original patent, in line 49 and the period at the end of the paragraph. The substitute specification filed April 7, 2000 has not been entered as the proposed amendment to column 1 line 20 has improperly bracketed the language "flexographic" to be inserted while not deleting the language "flexo".

Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 C.F.R. § 1.121. The requirement that amended claims 91, 94, 97, and 100 as submitted on March 12, 2001 state "(Amended)" has been waived by the Examiner.

Claims 42 - 87, 94, 95, 100 - 102, 109, 110, 112, 113, 119 - 123, 125, 127 - 137, 139, and 141 - 151 are rejected under 35 U.S.C. 251 as being based upon new matter added to the

patent for which reissue is sought. The added material which is not supported by the prior patent is addressed below in the 35 U.S.C. 112, first paragraph, rejection.

Claims 42 - 87, 94, 95, 100 - 102, 109, 110, 112, 113, 119 - 123, 125, 127 - 137, 139, and 141 - 151 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

First, there is no adequate support in the disclosure for the substrate being printed on the other side, i.e. perfector printing. The disclosure in column 2 lines 54 - 55 only refers to the prior art without any specific reference to the instant invention. Furthermore, the various references to "over" are not deemed to imply perfector printing. While the Supplemental Declaration to Prince filed 7/7/00 has been carefully considered there is no objective evidence indicating that "over" as used in the instant disclosure refers to perfector printing. The submitted article from Graphic Arts Monthly only uses the term "over" in a very narrow context, e.g. "four over four perfector press" which does not equate to the various and random instances of "over" throughout applicant's disclosure. Secondly, the disclosure of a continuous in-line process does not necessarily imply perfector printing. It is possible that a continuous in-line process can result only in a desired single side printed substrate.

Second, the disclosure provides no support for the anilox roller being mounted in a "dedicated" flexographic printing station as recited in claims ~~93, 96, 99, 102, 108, 113, 118,~~
~~123, 130, and 144.~~ First, it cannot be accurately determined what exactly applicant considers

a "dedicated" station. It is noted that the disclosure only refers to modifying an existing lithographic station with a retractable coating unit to provide a flexographic printing station. See column 4 lines 47 - 49, column 6 lines 59 - 62, column 7 lines 7 - 9, 24 - 25, 39 - 41, 49 - 50, and column 8 lines 13 - 14.

✓ Third, the disclosure does not support printing the slurry at "any" of the printing stations. It is noted that only the flexographic printing stations are disclosed as printing the slurry.

✓ Fourth, the disclosure does not provide support for the terminology "thin controlled layers" as is recited in claim 72.

Claim 78 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim ~~78~~, as amended, does not depend from any other claim. (Although not improper, it is noted that claim 111 depends from claim 103 and not intervening independent claim 109).

Claims 9, 17 - 29, 44 - 79, 82 - 87, 89, and 91 - 151 are objected to under 37 C.F.R. 1.75(a) as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Overall, the claims contain numerous instances of inconsistent terminology confusing the scope of the claims. In particular, note the subsequent plural recitations of structure following a recitation of "at least one" and "one or more" of that structure. For example, a recitation of "said flexographic stations" following a first recitation of "at least one flexographic station" renders the scope of the claim indefinite in that it cannot be accurately determined if there is one

or more than one flexographic station being recited. The following are instances only and applicant should review all of the claims carefully for any other instances of indefiniteness.

In each of claims ~~9~~, ~~17~~, ~~52~~, 54, 55, 60, 91, 94, 97, 100, 103, 109, 114, and 119 the recitation of the impression cylinder transferring the image from the blanket cylinder to the substrate is misleading in that it appears to recite that the impression cylinder is between the blanket cylinder and the substrate.

In each of claims ~~21~~ and ~~64~~ it is not clear which colored ink images are printed by the halftone printing plates.

In claim ~~44~~ lines 10 and 14 the recitation "at least one of" is inconsistent with following recitation of "stations". This could be corrected by reciting in lines 13 - 14 --of that previously printed at said at least one successive printing station--. In claims 45 and 46 note the confusing recitations of "images" and "stations".

In claim ~~55~~ line 7 note the recitation "flexographic stations" following the recitation in line 6 of "at least one of said printing stations being". In claim 57 line 3 note the recitation "each flexographic station".

In claim 58 lines 7 - 8 the recitation of a blanket cylinder at "at least a first one" of said stations does not necessarily provide proper antecedent basis for "said blanket cylinder" in line 11 at "the other" of said stations. In claim 59 note also that the recitation of a plate cylinder "at said at least first one of said stations" does not positively recite a plate cylinder at the other station where the flexographic ink-providing means has been recited.

In claim 60 it is not apparent how a multicolored image is formed wherein the succeeding

station can print on the opposite side of the substrate as the first station. In lines 6 - 7 it cannot be accurately determined if plural lithographic and/or flexographic stations is recited. For example, does this recitation positively recite more than one lithographic station and more than one flexographic station? In claims 61, 62, and 67 - 71 the type of ink would appear to lack proper antecedent basis as the ink is only inferentially recited in claim 60. In claim 66 it is not apparent how the apparatus includes a sheet-fed press. Isn't the apparatus a press itself? It would appear to be more accurate to recite a sheet feeder.

In claim 72 the recitation of "a plurality of successive lithographic/flexographic stations" is vague and indefinite for the reasons stated above with respect to claim 60. In each of claims 73 - 76 "said colored ink images" and "said colored inks" lack proper antecedent bases.

In claim 82 step (3) line 2 "a substrate" is a double recitation of the same in step (1).

In claim 85 line 5 "said substrate" lacks proper antecedent basis and in line 8 "a substrate" is a double recitation. In step (4) line 2 "such" should be --said--.

In claim 86 step (4) lines 3 - 4 "said lithographic materials" lacks proper antecedent basis.

In claim 87 lines 5 - 6 it cannot be accurately determined if plural lithographic and/or flexographic stations is recited. Note the comments above with respect to claim 60. In line 8 -said-- should be inserted before "one or more".

In claim 89 "the impression cylinder" lacks proper antecedent basis.

In each of claims 91, 94, 97, 100, 103, 109, 114, 119 it is not clear how the flexographic plate on the blanket cylinder transfers a flexographic image to the blanket cylinder

which underlies the flexographic plate. Additionally, in each of the above claims it is not apparent how the anilox roller transfers a flexographic image to the plate as there is no image on the anilox roller. In other words, the image is formed on the plate not the anilox roller. Furthermore, applicant should carefully each of the above claims, and their dependent claims, for inconsistent and improper plural recitations as noted above. In particular, note the recitations of "lithographic stations", "flexographic stations", and "images" throughout the claims wherein only "at least one of" or "one or more" of such has been previously recited. Note also the recitations including the terminology "each".

Claim 91 is incomplete as it does not end in a period. In claim 91 step (4) "said substrate" lacks proper antecedent basis, in claim 94 step (3) line 2 "said substract" [sic] lacks proper antecedent basis, in claim 100 step (2) line 2 "said plate cylinder" lacks proper antecedent basis and in step (c) line 2 "lithographic" should be --lithography--, in claim 107 line 3 --cylinder-- should be inserted after "blanket", in claim 109 lines 4 and 6 "said substrate" lacks proper antecedent basis, in claims 115 and 116 "method" should be --apparatus--, in claims 115 and 117 "114wherein" should be separated, and in claim 116 "said substrate" lacks proper antecedent basis.

Claim ~~96~~ is a duplicate of claim 93 as they both depend from claim 91. See M.P.E.P. 706.03(k).

In claim 120 there is no recitation of structure to provide the function of feeding sheets.

In claim 121 "said substrate" lacks proper antecedent basis as it has only been inferentially recited in parent claim 119.

In each of claims 124, 125, 138, and 139, and their dependent claims note the above comments with respect to claims 91+.

Claims 137 and 151 appear to modify rather than further restrict claims 135 and 149 by reciting that the flexographic images are both an opaque color ink and a slurry.

In claims 141 and 142 "said substrate" lacks proper antecedent basis as it is only inferentially recited in parent claims 138 and 139.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 - 8, 38, and 49 - 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland (G 93 05 552.8) in view of Pantone and Offsetpraxis. MAN Roland teaches a combined lithographic and flexographic apparatus and process wherein a flexographic unit may be placed upstream of the lithographic units. (It is noted that MAN Roland discloses printing metallic inks in the body of the disclosure.) Pantone teaches the conventionality of printing/coating metallic inks **upstream** of other colors. Offsetpraxis teaches metallic inks having an aqueous based vehicle. It would have been obvious to one of ordinary skill in the art to utilize the apparatus and method of MAN Roland to print aqueous based metallic inks in view of Pantone and Offsetpraxis to achieve a superior metallic image. With respect to claim 49 the alternative limitation "or" printing on the opposite side does not positively recite actually printing on the other side of the substrate. With respect to the dependent claims it would have been obvious to one of ordinary skill in the art through routine experimentation to use either uniform or non-uniform sized metal particles to achieve the desired metallic effect.

Claims 9 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Pantone and Offsetpraxis as applied to the claims above, and further in view of Bird (US 4,841,903). Bird teaches the conventionality of an adapted flexographic unit (12) wherein the flexographic plate (20a) is mounted on a plate cylinder which contacts a blanket cylinder (23a). See the entire disclosure of Bird. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of MAN Roland, as modified by Pantone and Offsetpraxis, with a plate cylinder mounted flexographic plate and blanket cylinder in view of Bird so as to selectively utilize the unit as a flexographic or lithographic unit. Note the anilox

roller of MAN Roland.

Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Pantone and Offsetpraxis as applied to claims 6 - 8, 38, and 49 - 51 above, and further in view of Schone et al. (US 4,188,883). Schone et al. teach the conventionality of perfecter printing. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of MAN Roland, as modified by Pantone and Offsetpraxis, with perfecter printing in view of Schone et al. so as to print both sides of the substrate in one pass.

Claims 10, 29, and 31 - 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Satterwhite (US 4,308,796). While the claims of MAN Roland do not specifically recite printing a flexographic color ink image with the flexographic unit, it is noted that the disclosure of MAN Roland clarifies that the lacquer recited in the claims could be a colored image. However, Satterwhite teaches a flexographic unit for either coating or printing a flexographic image. See the Abstract and column 2 line 40 through column 3 line 10 of Satterwhite. It would have been obvious to one of ordinary skill in the art to provide the apparatus and process disclosed by MAN Roland with the capability of printing a flexographic image in view of Satterwhite to achieve the benefits of printing with a flexographic unit. With respect to the dependent claims note that MAN Roland teaches an overcoating unit and both waterless (dry lithography) and solvent based inks are notoriously conventional in the art.

Claims 11, 30, and 60 - 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Satterwhite as applied to the claims above, and further in view of Bird ('903). Bird teaches the conventionality of an adapted flexographic unit (12) wherein

the flexographic plate (20a) is mounted on a plate cylinder which contacts a blanket cylinder (23a) and the conventionality of interstation dryers (25, 25a). See the entire disclosure of Bird. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of MAN Roland, as modified by Satterwhite, with a plate cylinder mounted flexographic plate and blanket cylinder in view of Bird so as to selectively utilize the unit as a flexographic or lithographic unit. Additionally, it would have been obvious to one of ordinary skill in the art to provide the apparatus and method of MAN Roland, as modified by Satterwhite, with interstation dryers in view of Bird so as to dry the images before subsequent printing and/or coating.

Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Satterwhite and Bird as applied to claims 11, 30, and 60 - 66 above, and further in view of Schumacher et al. (US 5,079,044). Schumacher et al. teach the conventionality of printing an encapsulated essence. See column 1 lines 29 - 31 of Schumacher et al., for example. It would have been obvious to one of ordinary skill in the art to provide the method of MAN Roland, as modified by Satterwhite and Bird, with the step of printing an encapsulated essence in view of Schumacher et al. to apply a sufficiently heavy coating.

Claims 68 - 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Satterwhite and Bird as applied to claims 11, 30, and 60 - 66 above, and further in view of Pantone and Offsetpraxis. Pantone and Offsetpraxis have been addressed above. It would have been obvious to one of ordinary skill in the art to utilize the apparatus and method of MAN Roland, as modified by Satterwhite and Bird, to print aqueous based metallic

inks in view of Pantone and Offsetpraxis to achieve a superior metallic image.

Claims 34 - 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Satterwhite as applied to claims 10, 29, and 31 - 33 above, and further in view of Schumacher et al. (US 5,079,044). Schumacher et al. teach the conventionality of printing an encapsulate essence. See column 1 lines 29 - 31 of Schumacher et al., for example. It would have been obvious to one of ordinary skill in the art to provide the method of MAN Roland, as modified by Satterwhite, with the step of printing an encapsulated essence in view of Schumacher et al. to apply a sufficiently heavy coating. With respect to claim 36 UV curing is notoriously conventional in the art.

Claims 42, 43, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Satterwhite as applied to claims 10, 29, and 31 - 33 above, and further in view of Schone et al. Schone et al. has been addressed above. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of MAN Roland, as modified by Satterwhite, with perfector printing in view of Schone et al. so as to print both sides of the substrate in one pass.

Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Satterwhite and Schone et al. as applied to claims 42, 43, and 53 above, and further in view of Bird. Bird has been addressed above. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of MAN Roland, as modified by Satterwhite and Schone et al., with a plate cylinder mounted flexographic plate and blanket cylinder in view of Bird so as to selectively utilize the unit as a flexographic or lithographic unit.

Claims 15 - 23, 37, 44 - 48, 55, 88 - 93, 97 - 99, 103 - 108, 114 - 118, 124, 126 - 130, 138, and 140 - 144 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Bird ('903). MAN Roland and Bird have been addressed above. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of MAN Roland with a plate cylinder mounted flexographic plate and blanket cylinder in view of Bird so as to selectively utilize the unit as a flexographic or lithographic unit. With respect to the dependent claims lithographic halftone printing is notoriously conventional in the art as well as lithographic and flexographic solid printing and both sheet fed and web fed units are conventional in the art. Note that MAN Roland teaches a dedicated flexographic station whereas Bird teaches a retractable coater flexographic unit so as to permit selective use of the unit as either a lithographic or flexographic unit.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Bird as applied to the claims above, and further in view of Schumacher et al. Schumacher et al. has been addressed above. It would have been obvious to one of ordinary skill in the art to provide the method of MAN Roland, as modified by Bird, with the step of printing an encapsulated essence in view of Schumacher et al. to apply a sufficiently heavy coating.

Claims 25 - 28, 131 - 134, and 145 - 148 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Bird as applied to the claims above, and further in view of Pantone and Offsetpraxis. Pantone and Offsetpraxis have been addressed above. It would have been obvious to one of ordinary skill in the art to utilize the apparatus and method

of MAN Roland, as modified by Bird, to print aqueous based metallic inks in view of Pantone and Offsetpraxis to achieve a superior metallic image.

Claims 56, 57, 135, 136, 149, and 150 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Bird as applied to the claims above, and further in view of Roulleau (US 4,109,572). Roulleau teaches printing an opaque white ink by flexography. See column 3 lines 61 - 68 of Roulleau. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of MAN Roland, as modified by Bird, with the step of printing with an opaque white ink in view of Roulleau so as to provide sufficient contrast for subsequently printed colors.

Claims 137 and 151 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Bird and Roulleau as applied to claims 56, 57, 135, 136, 149, and 150 above, and further in view of Schumacher et al. Schumacher et al. has been addressed above. It would have been obvious to one of ordinary skill in the art to provide the method of MAN Roland, as modified by Bird and Roulleau, with the step of printing an encapsulated essence in view of Schumacher et al. to apply a sufficiently heavy coating.

Claims 42, 43, 80, 81, 94 - 96, 100 - 102, 109 - 113, 119 - 123, 125, 127 - 130, 139, and 141 - 144 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Bird and Schone et al. Each of MAN Roland, Bird, and Schone et al. have been addressed above. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of MAN Roland, as modified by Bird, with perfect printing in view of Schone et al. so as to print both sides of the substrate in one pass.

Claims 131 - 134 and 145 - 148 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Bird and Schone et al. as applied to the claims above, and further in view of Pantone and Offsetpraxis. Pantone and Offsetpraxis have been addressed above. It would have been obvious to one of ordinary skill in the art to utilize the apparatus and method of MAN Roland, as modified by Bird and Schone et al., to print aqueous based metallic inks in view of Pantone and Offsetpraxis to achieve a superior metallic image.

Claims 135, 136, 149, and 150 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Bird and Schone et al. as applied to the claims above, and further in view of Roulleau. Roulleau has been addressed above. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of MAN Roland, as modified by Bird and Schone et al., with the step of printing with an opaque white ink in view of Roulleau so as to provide sufficient contrast for subsequently printed colors.

Claims 137 and 151 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Bird, Schone et al., and Roulleau as applied to claims 135, 136, 149, and 150 above, and further in view of Schumacher et al. Schumacher et al. has been addressed above. It would have been obvious to one of ordinary skill in the art to provide the method of MAN Roland, as modified by Bird, Schone et al., and Roulleau, with the step of printing an encapsulated essence in view of Schumacher et al. to apply a sufficiently heavy coating.

Claims 72, 74, 76, 86, and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Schone et al. Both MAN Roland and Schone et al. have been addressed above. It would have been obvious to one of ordinary skill in the art to provide the

apparatus and method of MAN Roland with perfector printing in view of Schone et al. so as to print both sides of the substrate in one pass.

Claim 73 is rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Schone et al. as applied to claims 72, 74, 76, 86, and 87 above, and further in view of Bird. Bird has been addressed above. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of MAN Roland, as modified by Schone et al., with a plate cylinder mounted flexographic plate and blanket cylinder in view of Bird so as to selectively utilize the unit as a flexographic or lithographic unit.

Claims 77 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Schone et al. as applied to claims 72, 74, 76, 86, and 87 above, and further in view of Schumacher et al. Schumacher et al. has been addressed above. It would have been obvious to one of ordinary skill in the art to provide the method of MAN Roland, as modified by Schone et al., with the step of printing an encapsulated essence in view of Schumacher et al. to apply a sufficiently heavy coating. With respect to claim 79 UV curing is notoriously conventional in the art.

Claims 6, 10, 29, 31, 38, 44 - 46, and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Hartung et al. (US 5,638,752). Hartung et al. teach the apparatus and method as recited. See the entire disclosure of Hartung et al.

Claims 6, 10, 29, 31, 38, 44 - 46, and 49 are rejected under 35 U.S.C. 102(a) as being anticipated by Hartung et al. (EP 620,115). Hartung et al. teach the apparatus and method as recited. See the translation of Hartung et al.

Claims 7, 8, 32, 33, 47, 48, 50, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartung et al. ('752) or ('115). Hartung et al. do not specifically disclose the size of the metallic particles, the types of inks, or the types of substrates. However, each of the recited sizes of particles, ink types, or substrate types would either have been obvious to one of ordinary skill in the art through routine experimentation or are conventional in the art.

Claims 9, 11, 15 - 23, 25 - 28, 30, 37, 52, 55 - 57, 60 - 66, 68 - 71, 88 - 90, 91 - 93, 97 - 99, 103 - 108, 114 - 118, 124, 126 - 134, 138, and 140 - 148 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartung et al. ('752) or ('115) in view of Bird. Bird has been addressed above. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of Hartung et al. with a plate cylinder mounted flexographic plate and blanket cylinder in view of Bird so as to selectively utilize the unit as a flexographic or lithographic unit. With respect to the dependent claims note the comments above.

Claims 53, 72, 74 - 76, 81, and 85 - 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartung et al. ('752) or ('115) in view of Schone et al. Schone et al. has been addressed above. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of Hartung et al. with perfecter printing in view of Schone et al. so as to print both sides of the substrate in one pass.

Claims 54, 73, 80, 94 - 96, 100 - 102, 109 - 113, 119 - 123, 125, 127 - 134, 139, and 142 - 148 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartung et al. ('752) or ('115) in view of Bird and Schone et al. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of Hartung et al. with a plate cylinder mounted

flexographic plate and blanket cylinder in view of Bird so as to selectively utilize the unit as a flexographic or lithographic unit and with perfector printing in view of Schone et al. so as to print both sides of the substrate in one pass.

If it is determined that the entire disclosure of MAN Roland is available as prior then the following rejection applies. However, on the most part, applicant's position that only the claims are available as prior art has been accepted lacking any available rulings to the contrary. However, applicant should noted M.P.E.P. 2128.

Claims 6, 10, 29, 31, 38, 44 - 46, and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by MAN Roland. MAN Roland teach the apparatus and method as recited. See the translation of MAN Roland.

The above rejections over Hartung et al. ('752) and ('115) have been made as no objective evidence has been provided to antedate the filing date of Hartung et al. ('752) or the disclosure date of Hartung et al. ('115).

Claims 1 - 5, 12 - 14, and 39 - 41 are allowed.

Claims 58, 59, and 82 - 84 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 and objections under 37 C.F.R. 1.75(a) set forth in this Office action.

Claim 78 cannot be examined relative to the prior art at this time due to its indefinite dependency.

The original patent, or an affidavit or declaration, as to loss of inaccessibility of the

original patent, must be received before this reissue application can be allowed. See 37 C.F.R. 1.178.

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. With respect to the 35 U.S.C. 112, first paragraph, rejection of new matter in the claims note the comments above. With respect to applicant's arguments, and the Prince Declaration, concerning the disclosure of MAN Roland (G 93 05 552.8), it is noted that the recitation of structure within those claims anticipates any method of using that structure. Furthermore, the allegation that MAN Roland does not disclose metallic inks is only relevant to a limited number of applicant's claims to which secondary references have been applied. However, the term "lacquer" as recited by MAN Roland can be interpreted as a metallic ink in light of the body of the disclosure.

The patent sought to be reissued by this application has been involved in litigation. Any documents and/or materials, including the defenses raised against validity or against enforceability because of fraud or inequitable conduct, which would be material to the examination of this reissue application are required to be made of record in response to this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Funk whose telephone number is (703) 308-0982. The examiner can normally be reached on Monday - Thursday from 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hilten, can be reached at (703) 308-0719. The fax number for incoming

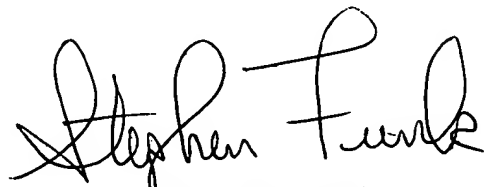
Serial No. 09/315,796
Art Unit 2854

-20-

official papers is (703) 308-7722, 7724. The fax number for informal papers in Art Unit 2854 is (703) 308-5841.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Stephen Funk
April 17, 2001



STEPHEN R. FUNK
PRIMARY EXAMINER

09/315,796-032099